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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/538,330

Filing Date: May 18, 2006

Appellant(s): FREYER, RUNE

Marlin R. Smith
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/15/2010 appealing from the Office action mailed 1/21/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-4, 6-8 and 10-14 are pending and have been finally rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,173,788	LEMBCKE ET AL.	1-2001
4,137,970	LAFLIN ET AL.	2-1979
WO 02/20941	FREYER	3-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 6-8, 10-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lembcke et al. (US 6,173,788) in view of Laflin et al. (US 4,137,970). Lembcke et al. disclose a cable duct device in a swellable packer comprising: a swellable packer (12) adapted for sealing an annulus; at least one through going opening positioned between an inner surface and an outer surface of the packer adapted to constitute a duct for a cable (16, col. 2, lines 51-57; longitudinal bore or the longitudinal split gap); a slit extending between the through-going opening and an outer surface of the packer prior to actuation of the packer (col. 2, lines 51-57; the description of a longitudinal bore instead of a groove or the longitudinally split segments would both provide an opening connected with the outer surface by a slit prior to actuation of the

packer); wherein the opening encloses the cable prior to and after the swelling has occurred (col. 2, lines 51-57, the longitudinal bore or longitudinally split segments would enclose the wire before actuation); wherein the opening may have variable longitudinal extension or variable cross-section (these features are considered obvious over the disclosure of Lembcke since one of ordinary skill in the art being enabled to produce the device of Lembcke would also be enabled to provide the opening as any dimensions a particular application may require). Lembcke et al. also disclose a method of extending a cable longitudinally through a packer comprising: providing a swellable packer including a seal material having an opening extending longitudinally through the seal material (fig 1a and as above), and a longitudinal slit extending between the opening and an external surface of the packer and inserting a cable through the slit (fig 1a, col. 2, lines 51-57) and swelling the seal to cause the seal to seal about the cable in the opening (fig 2a).

Lembcke et al. do not disclose the seal material as swelling and increasing in volume in response to contact with a swell-activating material. Laflin et al. disclose a packer including a seal material which swells and thereby increases in volume in response to contact with a swell-activating material (col. 3, lines 16-19) wherein the swell activating material comprises water (col. 3, lines 56-62). It would have been obvious to one of ordinary skill in the art at the time of invention to replace the seal of Lembcke et al. with the swellable material of Laflin et al. since the Laflin et al. suggest such a substitution (col. 3, lines 63+) and it has been held that the substitution of a

known element for another to obtain predictable results is obvious to one of ordinary skill.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lembcke et al. (US 6,173,788) in view of Freyer (WO 02/20941). Lembcke et al. disclose a method of extending a cable longitudinally through a packer comprising: providing a swellable packer including a seal material having an opening extending longitudinally through the seal material, and a longitudinal slit extending between the opening and an external surface of the packer prior to actuation of the packer (col. 2, lines 48-57 describe embodiments which require such) and inserting a cable through the slit (fig 1) and swelling the seal to cause the seal to seal about the cable in the opening (fig 2). Lembcke et al. do not disclose the seal material as swelling and increasing in volume in response to contact with a swell-activating material, wherein the material comprises hydrocarbons. Freyer discloses a packer material which swells by absorption of hydrocarbons to form an annular wellbore seal (abstract). It would have been obvious at the time of invention to substitute the hydrocarbon absorbing packer material of Freyer for the packer material of Lembcke et al. to arrive at the instant invention since the simple substitution of one known element for another to obtain predictable results has been held as obvious to one of ordinary skill.

(10) Response to Argument

Appellant argues that Lembcke et al. requires longitudinal compression of his packer in order to affect the seal around the control line and therefore one of ordinary skill would not substitute a swelling material (such as that of Laflin et al.) for the sealing element. The examiner disagrees. Lembcke et al. do disclose an embodiment which does not require compression to enclose the control line. In col. 2, lines 48-52, it is described that a "longitudinal bore" may be provided rather than the groove shown in figures 1 or 1a. Providing such a groove as described would surround and encompass the control line. Further, Lembcke et al. only *preferably* (col. 2, lines 36-37) provides a longitudinally compressed element, and does not require such an element to carry out the invention. One of ordinary skill in possession of the teachings of Lembcke et al. would recognize that only an expanding packer (not necessary expanding by compression) would be required to carry out the invention as taught.

Claims 1-4, 6-8, 10-12 and 14 as rejected under 35 USC 103(a) as unpatentable over U.S. Patent 6,173,788 (Lembcke et al.) in view of U.S. Patent 4,137,970 (Laflin et al.)

Claims 1, 3, 4, 6-8, and 10

Appellant argues that one of ordinary skill would not make the substitution of the swellable packer material of Laflin et al. which swells on contact with a swell-activating material for the swellable packer material of Lembcke et al. which swells upon longitudinal compression because there is no teaching, suggestion or motivation to

make such a substitution. The examiner disagrees. The secondary reference (Laflin et al.) does teach such a substitution of materials (col. 3, lines 63+) and even teaches how such a substitution may be advantageous when used in many boreholes (col. 4, lines 1-15). However, even if a specific teaching or motivation were not present, KSR forecloses the argument that a *specific* teaching, suggestion, or motivation is required to support a finding of obviousness (see the recent Board decision *Ex parte Smith*, -- USPQ2d--, slip op. at 20, Bd. Pat. App. & Interf. June 25, 2007).

Claim 2

Appellant argues that neither reference, Lembcke et al. or Laflin et al. disclose a through-going opening that encloses the cable both prior to and after swelling has occurred. The examiner disagrees because Lembcke et al. do disclose this limitation. In col. 2, lines 51-52, Lembcke et al. teach "a longitudinal bore can be used instead of a groove." A "bore" as taught would enclose the cable both prior to and after swelling has occurred.

Claims 11-14

Appellant argues that a *prima facie* case of obviousness has not been made out since neither Lembcke et al. or Laflin et al. describe inserting a cable into an opening through a slit, sealing about the cable in the opening by swelling a seal material, or that the swelling step is performed after the cable is inserted. The examiner disagrees. As described by Lembcke et al. in col. 2, lines 51-57, "[t]he sealing element can be made

from a plurality of segments, longitudinally split so that they define by their gaps a place for insertions of the conductor or I-wire." The description of the longitudinally split segments having gaps that define "a place for the insertions" of a cable appear to alone provide the step of providing a packer with a slit, as claimed, and inserting the cable within the slit. The substitution with the swellable material of Laflin et al., would then provide the step of swelling the material after such an insertion.

Appellant further argues that one of ordinary skill would not make such a combination as presented by the examiner since the combination is much more than substitution of one known element for another. The examiner disagrees because one of ordinary skill would recognize that the combination as presented would have at least a reasonable expectation of success and is further motivated by the secondary reference (Laflin et al. col. 4, lines 1-15). Appellant appears to further argue that the claimed invention should be further considered non-obvious because of secondary considerations such as, long-felt need in the art or the failure of others, but provides no specific arguments or evidence supporting such.

Claim 13 as rejected under 35 USC 103(a) as unpatentable over U.S. Patent 6,173,788 (Lembcke et al.) in view of International Publication WO 02/20941 (Freyer)

Appellant argues that one of ordinary skill would not make the combination as presented by the examiner because there is no teaching or suggestion to make such a

combination. The examiner disagrees since, as similarly presented above, a combination of the prior art does not require an explicit teaching or suggestion from the prior art to be obvious to one of ordinary skill. One of ordinary skill in possession of the references would immediately recognize the equivalence of the packer materials in that they are both well known (as demonstrated by the cited references) for use in creating packer seals in wellbores. Appellant appears to further argue that the claimed invention should be further considered non-obvious because of secondary considerations such as, long-felt need in the art or the failure of others, but provides no specific arguments or evidence supporting such.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/David J. Bagnell/
Supervisory Patent Examiner, Art Unit 3672

Conferees:

Marc Jimenez /MJ/

David Bagnell /DJB/

David Andrews /DLA/

8/18/10